

REMARKS

Entry of this Amendment and reconsideration in light thereof are respectfully requested. By means of the present Amendment, claims 12-22 have been cancelled, and claim 1 has been amended. The amendments to claim 1 are of a formal nature in order to overcome a rejection under 35 U.S.C. 112, second paragraph. Accordingly, the amendments to claim 1 do not raise any new issues and do not require any further searching by the Examiner. Additionally, it is believed that upon entry of this Amendment, the application will be placed in condition for allowance, or, in any event, reduce the number of issues for appeal. Accordingly, entry of this Amendment and reconsideration in light thereof are respectfully requested.

In the final Office Action dated April 27, 2004, the Examiner objected to amended claim 18 as being directed to a non-elected invention. Accordingly, the Examiner withdrew claim 18 from consideration. By means of the present Amendment, claim 18 has been cancelled from the application. Therefore, this objection has been rendered moot.

In the final Office Action dated April 27, 2004, the Examiner rejected claims 1-17 and 19-22 under 35 U.S.C. 112, second paragraph. The Examiner noted several informalities in these claims. With regard to the informalities in any of claims 12-22, these claims have been cancelled from the application. Accordingly, the Examiner's rejection of claims 12-22 under 35 U.S.C. 112, second paragraph, has been rendered moot.

With regard to the informalities noted by the Examiner in claim 1, this claim has been amended in order to remove these informalities. Specifically, the language "and silicon powder is fed into the molten surface," has been deleted from the preamble. This language appears in the

preamble in order to provide a description of the general objective of the claimed invention. However, as this language may appear to conflict with the more detailed steps of the claim, namely, that the silicon powder is deposited on the surface of the structural member in a region which has not yet been irradiated by the laser beam, the objectionable language in the preamble has been removed.

With regard to term “the liquified matrix alloy” which appears in step (c) of claim 1, antecedent basis for this terminology has been provided in the preamble of claim 1.

Accordingly, it is requested that the rejection under 35 U.S.C. 112, second paragraph, be withdrawn.

In the final Office Action dated April 27, 2004, the Examiner rejected claims 12-22 under 35 U.S.C. 103(a) based on various combinations of the prior art. However, as claims 12-22 have been cancelled, this ground for rejection has been rendered moot.

In the final Office Action dated April 27, 2004, the Examiner rejected claims 1-11 under 35 U.S.C. 103(a) relying principally on US 6,548,125 (Warnecke, US ‘125), in combination with various other prior art references cited by the Examiner. US ‘125 issued on April 15, 2003, and is based upon App. No. 09/559,826, filed on April 28, 2000. Pursuant to 35 U.S.C. 102(e), US ‘125 is effective from a date of April 28, 2000, as a prior art reference.

The present application was filed in the PTO on May 22, 2002, and is based upon PCT App. No. EP01/01932, filed February 21, 2001. The present application also claims priority based upon two German patent applications, namely, DE 200 03 515 and DE 100 09 250, both of which were filed in the German Patent Office on February 28, 2000. Sworn translations of these

priority documents are submitted herewith and certified copies thereof will be filed shortly.

These priority documents support claims 1-11 as amended herein. Therefore, applicants have perfected their claim for priority based on the German applications, and the present application is entitled to an effective filing date of February 28, 2000. This date is earlier than the April 28, 2000 date accorded to US '125 for prior art purposes under 35 U.S.C. 102(e).

Accordingly, withdrawal of the rejection of claims 1-11 under 35 U.S.C. 103(a) which relies upon US '125 is respectfully requested.

In the final Office Action dated April 27, 2004, the Examiner rejected claims 1-2, 5-8, and 10 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of US 6,575,130 (Feikus, US '130) in view of Hayashizaki et al. The Examiner also rejected claims 1-2 and 5-12 under 35 U.S.C. 103(a) as being unpatentable over US 6,303,897 (Bady et al., US '897) in view of Hayashizaki et al. and other prior art references. The Examiner further rejected claims 1-2 and 5-12 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 4-10, and 12 of US '897.

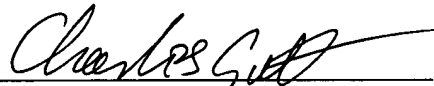
In order to overcome these grounds for rejection, applicants submit herewith a terminal disclaimer whereby they have disclaimed the terminal part of any patent which issues from the present application which extends beyond the terms of US '130 and US '897. Applicants further state for the record that the assignee of the present application and US '130, VAW Aluminum AG, and the assignee of US '897, VAW Motor GmbH, belonged to the same parent company at the time of the inventions of each of these patent documents.

Based on the foregoing, the rejections based on the judicially created doctrine of obviousness-type double patenting, and the rejection under 35 U.S.C. 103(a) which relied on US '897 are overcome and withdrawal thereof are respectfully requested.

In view of the foregoing, it is believed that the present application is now in condition for allowance, and a favorable action on the merits is respectfully requested. If the present application does not place the application in condition for allowance, the Examiner is kindly requested to telephone the undersigned at the telephone number given below so that applicants can decide what steps to take next.

Respectfully submitted,

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Enclosures: Certified Copies of Priority Documents DE 200 03 515.0 and
DE 100 09 250 (to follow)
Sworn Translations of Priority Documents
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Petition for Extension of Time